

### **In the Drawings**

Please substitute the accompanying replacement sheet for original Figure 1.

The replacement sheet removes the temporary label “text” which appeared in box 190 of the figures as originally filed.

## REMARKS

This Amendment responds to the Office Action mailed July 6, 2007. Claims 1, 2 and 14 have been amended, claim 3 has been canceled and new claims 20-21 have been added. Figure 1 has been replaced with a new drawing sheet.

Claims 1-19 were rejected as obvious over Sekikawa modified in view of Cummins. Applicant respectfully traverses the rejection.

### **The Amended Claims Distinguish Over Sekikawa In View of Cummins**

With respect to claim 1, the Patent Office cites Sekikawa as disclosing the claimed drive unit, the selector, and the operational logic. For the remaining features of that claim, the Patent Office proposes to modify the structure of Sekikawa to include the certain features of Cummins which the Patent Office acknowledges are not taught or suggested by Sekikawa, including a CD picker and a supply of CDs that are delivered in response to a load drive signal.

Devices for packaging and duplicating optical discs are conventional, but have not been adapted either structurally or communicatively for use in a paper copier machine to solve the problems recognized by the present inventor. Claim 1 is written as a *Jepson* claim, reciting the known components in the preamble and the improvement in the body of the claim. The claimed improvement provides a tray sized and positioned in the digital copier machine so as to occupy a space ordinarily reserved for the at least one paper bin. See Figures 1 and 4 of the subject application. The tray includes the combination of an optical drive unit and a picker and replaces a conventional paper bin, while having communication between the drive unit of the tray and the operational logic of the digital copier machine. The drive unit is connected to the digital copier so that controls on the copier can cause the picker to load the drive unit, write to a disc, and dispense the disc without the user having to supply a disc. Support for this feature is described at page 6, line 20 to page 7, line 11 of the Specification. As a result, a digital copier machine can be retrofit with a tray and operational logic as claimed to enable a user to select an optical disc as the target for output information without the need for the user to have a disc of his or her own beforehand.

Neither Sekikawa nor Cummins teaches or suggests an improved digital copier machine with a tray configured to supply and write to optical discs as recited in claim 1. Accordingly reconsideration of the rejection of claim 1 is warranted in view of the claim amendments.

Claim 14 has been similarly amended to recite that the claimed method for controlling a job output of a digital copier machine concerns a machine of the type that includes at least one paper bin for supplying paper onto which a source document captured at a platen is transformed into digital data, and now recites the step of “supplying the removable digital storage medium from a supply contained in a tray which is sized and positioned in the digital copier machine so as to occupy a space ordinarily reserved for the at least one paper bin,” and has “an optical drive unit included within the tray.” Further, amended claim 14 has the additional step of “ejecting the digital storage medium from the drive unit into a return for retrieval from the tray” so that a user can copy a source document in paper form onto a digital storage medium provided from a supply included within a tray disposed where a paper bin is ordinarily located (see Fig. 4 and page 19, lines 15-16 of the Specification).

Neither Sekikawa nor Cummins teaches or suggests a method for controlling the job output of a digital copier machine as recited in claim 14 in which there is an optical drive unit within a tray ordinarily reserved for paper yet which is configured to supply and write to optical discs. Accordingly reconsideration of the rejection of claim 14 is warranted in view of the claim amendments.

#### **Newly Presented Claims 20 and 21**

Newly presented claim 20 is modeled after original claim 1 and recites substantially the same features, except that it further recites that the digital media are “optical discs” and that the digital data being conveyed between the control unit of the digital copier machine and the drive unit is from “the captured source document on the platen of the digital copier machine.” This latter feature is implicitly part of original claim 1 because the digital data referred to in the claim is from a source document captured on the platen, but has been made express to more particularly denote the field of the present invention (digital paper copier machines) and to more specifically recite the features that address the problem recognized by the inventor.

Applicant submits that Cummins is non-analogous art and not combinable with Sekikawa so as to constitute a proper rejection of the claims under 35 U.S.C. § 103(a) because it does not satisfy either of the applicable tests:

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. In re Clay, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986)

With respect to the first test, Cummins is clearly directed to a different field of endeavor than the subject matter of claim 20. Specifically, claim 20 concerns features of and improvements to *digital paper copy machines* whereas Cummins concerns optical disc copying and recording devices. Optical disc recording is certainly a part of the solution of the present invention, but devices for copying and recording onto optical discs are not part of the field of endeavor. Cummins relates to "printing" only insofar as it carries its CD picker on the same drive shaft as an inkjet printer mechanism used to label a CD, but this aspect of the Cummins disclosure does not transform it into a document within the field of the present invention.

With respect to the second test, Cummins is not fairly understood as being directed to the same problem addressed by the inventor. The specific problem addressed by the subject matter of claim 20 is improvements in the transportability of imaged documents captured on a platen of a digital copier. The particular problem is to replace paper without introducing complexities of interacting with networks and firewalls, file-naming conventions, or possessing raw media. *See, e.g.*, Field of the Invention and Background of Invention discussions on page 1 *et seq.* of the Specification. By contrast, Cummins has no pertinence to any problem associated with imaged document management as the technology of Cummins presupposes that content is available in a digital form for use by his machine.

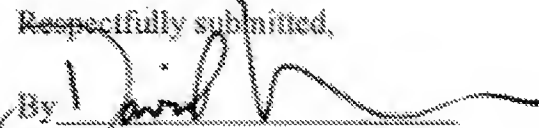
The requirement that a document be analogous art is a threshold matter before considering whether the document is a reference citable under 35 U.S.C. §§ 102 or 103. A document is analogous art if it is related to the same problem addressed by the inventor or is in the same field of endeavor. *In re Dimenski, supra*. Neither test is satisfied by the Cummins patent relative to the subject matter of claim 20.

Further, Cummins has entirely non-overlapping domestic and international patent classifications as compared to Sekikawa, and there is no overlap in the relevant fields of search identified on those two patents.

Consequently, Cummins cannot be used in combination with Sekikawa to reject claim 20 as being obvious. The Patent Office has acknowledged that Sekikawa does not disclose a CD picker and a supply of CDs that are delivered in response to a load drive signal. Accordingly, claim 20 and its dependent claim 21 are believed to be allowable over the art of record.

Reconsideration and allowance of all claims now pending is requested, with the understanding that further claims might be presented in a continuing application, including claims modeled after any of the pending or originally submitted claims.

Dated: September 17, 2007

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